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1761

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLN. OF: OWADES

SERIAL NO.: 09/833,924

FILED: April 12, 2001

FOR: PROCESS FOR PRODUCING A MALT BEVERAGE HAVING ...

GROUP: 1761

EXAMINER: CURTIS EDWARD SHERRER DOCKET: OW-20

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

TRANSMITTAL LETTER
APPELLANT'S BRIEF ON APPEAL

Dear Sir:

In connection with the above-entitled matter, enclosed please find the following:

1. Appellants' Brief on Appeal, together with **Appendices A through I** (in triplicate);

and

2. PTO Credit Card Payment Form PTO-2038 to cover the cost of filing the Appeal

Brief (\$165.00-Small Entity).

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account No. 08-1391.

Respectfully submitted,

01/14/2004 6WDRD0F1 00000037 09833924

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165.00 OP

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Serial No. 09/833,924

Docket No. OW-20

TRANSMITTAL LETTER - APPELLANTS' BRIEF ON APPEAL

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: MAIL STOP APPEAL BRIEF - PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 8, 2004 at Tucson, Arizona.

By



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APPELLANT'S BRIEF ON APPEAL

This Brief is being filed in support of Appellant's Appeal from the final rejection mailed September 26, 2003. A Notice of Appeal was timely filed under Certificate of Mailing on December 4, 2003.

REAL PARTY IN INTEREST

The Real Party in Interest in this Appeal is Joseph L. Owades, an individual, of Somona, California.

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RELATED APPEALS AND INTERFERENCES

To the best of the knowledge of the undersigned attorney and the Appellant, no other Appeals or Interferences exist which will affect or be directly affected, or have a bearing on, the instant Appeal.

STATUS OF THE CLAIMS ON APPEAL

Claims 1-5 and 7 stand finally rejected and are on Appeal. The claims on Appeal are set forth in **Appendix A**.

STATUS OF AMENDMENTS

A Final Action was mailed September 26, 2003. No Amendment was filed in response thereto. Rather, Appellant timely filed a Notice of Appeal under Certificate of Mailing on December 4, 2003.

SUMMARY OF THE INVENTION ON APPEAL

The invention on Appeal is directed to a brewing process, and more particularly, to a method of reducing bitterness of a brewed fermented malt beverage, i.e., a beer or ale.

The brewing of malt beverages is one of the oldest technologies developed by humans. Originally, brewing was developed, long before modern refrigeration techniques, as a method of preserving food values in vegetable products.

Beers and ales are made by an infusion of barley malt and other grains into warm water. Conventional mashing involves mixing together of malt and cereal adjuncts in warm water, followed by a series of heating and resting cycles. Following mashing, the soluble materials are

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extracted in a lauter tub, leaving behind the spent grain. A clear liquid (wort) obtained by the extraction may then be transferred to a brew kettle and boiled for a period of time which inactivates the malt enzymes, and extracts the bitterness principles of hops.

A typical wort used in brewing may be composed of the mixed extract of a barley malt mash and a cereal adjuncts mash, typically of corn grits or rice. Such mixed extract may be obtained by treating a dried barley malt with warm water, at about 50° C, in one vessel, the so-called "mash tub" and boiling the cereal adjuncts, (e.g. corn grits or rice) in another vessel, the so-called "cooker," and then adding the boiling contents of the cooker to the warm malt suspension in the mash tub. This serves to raise the temp. of the mash tub contents to about 57°-67° C. During the rise from 50° C., to about 67°C., and starting at around 63°C., the enzymes in the malt and in particular beta-amylase which is most active between 60° and 70°C., partially degrade the starches in both the malt itself and in the corn grits or rice to form simple fermentation sugars, primarily glucose, fructose and maltose. These simple sugars are fairly sweet tasting, and also are fermentable by Brewers' yeasts to alcohol and carbon dioxide.

The combination mash is then filtered in a lauter tub, mash filter or other means and the resulting wort boiled with hops to extract the bitter components and other components, filtered, cooled and fermented with yeast, and carbonated to produce a beer or ale. (Specification page 1, line 19-page 2, line 19).

Hops are universally used in the production of malt beverages such as beer or ales, because they impart important properties to these beverages. These include preservative, or anti-microbial properties, particularly against gram negative organisms; bitterness, imparted by a set of organic compounds called "humulones," which are isomerized by the brewing process to a

related set of compounds called "isohumulones;" aroma, a uniquely floral bouquet, characterized as "hop bouquet;" and foam enhancement, or "lacing," due to surface properties of some components of hops. (Specification, page 1, line 9-line 16).

The present invention provides an eloquent method for producing malt beverages having the desired characteristics of hops, i.e., preservative, anti-microbial, aroma and foam enhancement, (Specification, page 1, lines 11-12 and lines 14-15) without the typical bitterness of hops (Specification page 3, lines 2-4). More particularly, in accordance with the present invention, juniper berry oil is added to a brewed fermented malt beverage, i.e., following fermentation, in an amount below a threshold of taste for juniper berry oil (Specification, page 3, lines 6-9 and page 4, lines 3-4).

ISSUES PRESENTED ON APPEAL

The issues presented on Appeal:

- (1) Whether claims 1-5 and 7 are properly rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the Specification in such a way to enable one skilled in the art to which it pertains, or to which it is most nearly connected, to make and/or use the invention.
- (2) Whether claims 1-5 and 7 are properly rejected under 35 USC § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.
- (3) Whether claims 1-5 and 7 are obvious from Trees for Life.

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GROUPING OF CLAIMS

Claims 1, 4, 5 and 7 stand and fall together.

Claims 2 and 3 stand and fall together.

ARGUMENTS ON APPEAL

(1) The Examiner has been inconsistent.

Before considering the rejections on Appeal, it should be noted the Examiner has been unexplainably inconsistent in his rejection. Initially, the Examiner raised a 112, second paragraph of the claims (see Office Action dated November 1, 2002) which Appellant apparently addresses to the satisfaction of the Examiner. The Examiner then issued an Ex parte Quayle Action (Paper No. 10) in which he indicated all of the claims other than non-elected claims 8-11 to be allowable. Subsequently, and without any action on the part of Appellant other than the cancellation of non-elected claims 8-11, the Examiner reversed himself and issued the instant Final Rejection which is the basis of the current Appeal. In a subsequent telephone interview between Appellant's attorney and the Examiner, held October 8, 2003, Appellant's attorney queried the Examiner as to why he indicated the application to be allowable and then reversed himself. The Examiner offered no explanation. For the convenience of the Board a copy of Paper No. 10 is enclosed as **Appendix B** and a copy of Appellant's Interview Summary is enclosed as **Appendix C**.

(2) The rejection of claims 1-5 and 7 under 35 USC § 112, first paragraph, is in error.

Turning now to the specific reasons for rejection, the Examiner has rejected claims 1-5 and 7 under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement

on the basis that "Applicant has not fully disclosed amount of what types of juniper berry oil are necessary to practice the instant invention". The Examiner's rejection is in error.

Juniper berry oil is commercially available from a variety of sources. Even assuming arguendo that commercially available juniper berry oils may differ as to types or concentration, such fact per se does not make Appellant's claims non-enabled. As this honorable Board is well aware, 35 USC § 112, first paragraph, requires that the disclosure of an invention be "in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . ." Decisional law has interpreted this statutory requirement to require that sufficient information be given in the application so that one of ordinary skill in the art can practice the invention without the necessity for undue experimentation. *Fields v. Conover*, 58 CCPA 1366, 443 F.2d 1386, 170 USPQ 276 (1971); *In re Colianni*, 561 F.2d 220, 195, USPQ 150 (CCPA 1977); *Ex parte Jackson*, 217 USPQ 804 (BPAI 1982).

In rejecting the claims under 35 USC § 112, first paragraph, the Examiner takes the position that the claims are not enabled since the specific source of juniper berry oil was not described. Even assuming arguendo, the juniper berry oil may differ from source to source, at most, one skilled in the art would have to run a simple quantitative test to determine the amount of juniper berry oil in the source material so that the amount prescribed in claim 1, i.e., 0.010 ppm to 0.350 ppm based on the malt beverage, is added. Running a single quantitative test of a source material is hardly "undue experimentation".

Moreover, one skilled in the art also could run a simple taste test to determine whether a sufficient amount, or too much of a particular source of juniper berry oil is added. Claim 1

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specifies two criteria which would be readily apparent to one skilled in the art by a simple taste test:

- (1) Reduction of bitterness; and
- (2) Addition of juniper berry oil below a threshold of taste amount.

Since claim 1 specifies that the juniper berry oil is to be added to a fermented beverage, it would be a simple matter to brew a batch, split the batch into several aliquots, add varying amounts of juniper berry oil from particular source and taste. In other words, all that is required is a simple taste test.

The determination of what constitutes undue experimentation requires a standard of reasonableness in light of the nature of the invention and the state of the art. *Ex parte Jackson* at 807. In fact, even if a considerable amount of experimentation is required, the disclosure can nevertheless be legally enabling:

The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed to enable the determination of how to practice a desired embodiment of the invention claimed.

Id. (emphasis added); *see also, In re Rainer*, 52 CCPA 1593, 347 F.2d 574, 146 USPQ 218 (1965), and the Board of Appeal decision in *Ex parte Wayne R. Matson*, Appeal No. 1996-3409 (2000).

In the case at bar, we are talking about running a single quantative experiment to determine a concentration of juniper berry oil in a particular source that meets the specific claim

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language, or at best a few taste test comparisons. This hardly could be considered to be "undue experimentation".

Moreover, this Board can take Judicial Notice that foodstuffs including commercially sources of juniper berry oil must be labeled in order to be sold in the U.S. Thus, one simply needs to read the label to determine the amount to be added in order to achieve an amount of 0.010 ppm to 0.350 ppm based on the malt beverage as specified in claim 1.

Accordingly, the rejection of claim 1 and the several claims dependent directly or indirectly thereon under 35 USC § 112, first paragraph as failing to complying with the enablement requirement is in error.

(3) The rejection of claims 1-5 and 7 under 35 USC § 112, second paragraph as being indefinite is in error.

As discussed in Section (1) above, whatever the source of juniper berry oil, Appellant's written description is legally enabling.

Similarly, for the purposes of definiteness, it is well-settled that "[t]he fundamental purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so that the public is informed of the boundaries of what constitutes infringement of the patent." MPEP 2173. Appellant respectfully submits that there is nothing indefinite about the phrase "juniper berry oil" in the context of the subject application. As noted supra, juniper berry oil is commercially available from a variety of sources. Even assuming arguendo, the chemical constituents of juniper berry oil from different sources may vary slightly, this does not make the claim indefinite. The test of definiteness is whether a person with skill in the art can understand the language of the claim to know the metes and bounds of the claims. Simply put, if

one adds juniper berry oil to a malt beverage in an amount of 0.010 ppm to 0.350 ppm, and it reduces the bitterness of the beverage without imparting its own flavor, they will know they are infringing.

Moreover, other U.S. patents employ similar claim language. See, for example, claims 6 and 7 of U.S. Patent 4,816,220 and claim 8 of U.S. Patent 5,397,497 (copies enclosed as **Appendices D and E** for the convenience of the Board).

(4) The rejection of claims 2 and 3 under 35 USC § 112, second paragraph as being indefinite is in error.

Claims 2 and 3 have been rejected under 35 USC § 112, second paragraph as being indefinite on the basis that the scope of the term “aging” is unknown.

The term “aging” is a term of art well known to those in the malt beverage industry. Moreover, the “age” or “aging” appears in the claims of many U.S. Patents directed to production of beer or other malt beverages. See, for example, U.S. Patent Nos. 5,304,384, 5,346,706, 5,536,512 and 5,718,161, copies of which are enclosed as **Appendices F through I** for the convenience of the Board. It is noted Examiner Sherrer listed as the Examiner on the ‘384 and ‘512 Patents is believed the same Examiner Sherrer who passed the earlier Patents to issue. Assuming that to be the case, it appears the Examiner is being inconsistent and is applying a different standard here.

The Examiner, in the final rejection states in the paragraph bridging pages 3-4 “Without a detailed review of the cited patents’ prosecution, it is not clear whether the term “aging” was found to be defined in the respective specifications”. This Board can satisfy itself that the term “aging” in fact is not defined in either the ‘384 U.S. patent or the ‘512 U.S. patent which is a

continuation of the '384 patent. Thus, the Examiner's purpose in relying on this statement is misplaced.

The Examiner also attempts to justify his inconsistency by stating in that same paragraph "Further, a term can be found definite where it is clear on the record that the inclusion of that term in the claim is not pertinent to the claim's patentability". Yet, both the statements of the invention in the '384 and '512 patents and the detailed statements of the invention make specific reference to the aging step: See, for example Column 3, lines 25-31 of the '384 patent which states:

"According to the present invention there is provided a process for preparing a fermented malt beverage wherein: brewing materials are mashed with water; the resulting mash is heated and wort separated therefrom; the wort is boiled, cooled and fermented; and, the green beer is subjected to a finishing stage, which includes aging, to produce the beverage." (underlining added for emphasis).

Thus, the Examiner is being inconsistent in rejecting the instant claims on Appeal for including the term "aging" where he previously allowed similar claim language.

Accordingly, it is submitted that the rejection of claims 2 and 3 under 35 USC § 112, second paragraph is likewise in error.

(5) The rejection of claims 1-5 and 7 under 35 USC § 103 as being unpatentable over Trees for Life is in error.

In finally rejecting the claims as obvious from Trees for Life, the Examiner acknowledges (1) that the Trees for Life reference nowhere teaches adding the specific amounts of juniper berry oil specified by Appellant's claims. The Examiner also acknowledges (2) that Trees for Life fails to teach adding juniper berry oil during the aging process as specified by the claims on Appeal. And the Examiner acknowledges (3) that the Trees for Life reference fails to

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teach the beneficial effect of adding juniper berry oil in the claimed amount during the claimed aging step (i.e., of reducing bitterness without contributing a juniper berry flavor) specified by the claims on Appeal. Yet, the Examiner takes the position that “it would have been obvious to add the oil at any stage in the beverage making process because Courts have long held that the selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results”. The Trees for Life reference specifically and repeatedly discusses the use of juniper berries to add flavor to foods and beverages. See, for example, the third paragraph in which it is stated, “The berries are ground and added to sauces... to add a bitter, spicy flavor...”. Appellant’s claims describe reducing bitterness not adding bitterness! See also in the same paragraph the statement that the berries “were used to flavor bread and cakes”. And, in the same paragraph, the writer reports, “The best known use of the berries is in flavoring gin.” In a similar manner, in the same paragraph, the writer reports, “The berries are also used to flavor other alcoholic beverages...”. And, in the next paragraph, the writer reports, “... the berries were also used to flavor whiskey”. (Underlining added for emphasis.)

The claims on Appeal, on the other hand, specifically require the addition of juniper berry oil in “a below a threshold amount of 0.010 ppm to 0.350 ppm based on said malt beverage” in order to “reduce bitterness”. This is directly contrary to the teachings of the Trees for Life literature reference.

And, contrary to the Examiner’s suggestion, Appellant has not merely “recognized another advantage which would flow naturally from following the suggestion of the prior art”. In fact, Appellant has disregarded the teachings of the prior art, i.e. of adding juniper berry oil to flavor a beverage, and instead has added an extremely small and defined amount of juniper berry

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oil which is below the threshold of taste, to a brewed, fermented malt beverage, and found that such carefully controlled small addition unexpectedly results in a reduction in bitterness normally imparted to such beverage by hops. There is no disclosure or suggestion within the Trees for Life reference of adding juniper berry oil to a brewed fermented malt beverage, or for that matter, any beverage at the levels contemplated, or that addition of juniper berry oil to a brewed fermented malt beverage at the levels contemplated would have any beneficial effect, let alone the effect of reducing bitterness. To the contrary, as noted above, Trees for Life adds bitterness.

On page 4 of the final rejection, the Examiner argues:

“With regard to the prior art rejection, based on the Trees for Life reference, applicant argues that it only teaches adding juniper berry oil for flavoring purposes. Applicant has missed the teaching of using juniper berry oil for medicinal purposes and it would have been obvious to add it in any effective amount for said purposes”.

Here, the Examiner takes the teachings of Trees for Life out of context and/or applies the teachings of the present invention to the prior art. Note the statement at the bottom of the first page of Trees for Life:

“In medieval times the berries were also used to flavor whiskey in Scotland, though the whiskey might just have been used as a pleasant way to administer the medicinal benefits of juniper”. (underlining added for emphasis)

Certainly this description of the medicinal use of berries indicates that the berries were added in an amount above the threshold of taste. Additionally, the remainder of the paragraph bridging pages 1-2 of Trees for Life contains absolutely no teaching or suggestion that adding juniper berry oil to a brewed malt beverage at an amount below a threshold of taste amount as specified by the claims on Appeal would provide any benefit, medicinal or otherwise. It is therefore

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submitted the Examiner has applied impermissible hindsight and has applied the teachings of the present invention to the prior art to make out a case for obviousness. Thus, the rejection of claim 1 and the several claims 2-5 and 7 directly or indirectly dependent thereon as obvious from Trees for Life is in error.

SUMMARY AND CONCLUSIONS

The art of record fails to teach or suggest the addition of juniper berry oil in an amount below a threshold of taste to a brewed fermented beverage reduces the bitterness of that beverage. In fact, the Trees for Life reference cited by the Examiner is concerned with the use of juniper berry oil to flavor foods and beverages, and specifically teaches the addition of juniper berry oil adds a bitter flavor.

It would be readily ascertainable by one skilled in the art to determine the types and amount of juniper berry oil necessary to practice the claimed invention. Typically, all that one skilled in the art would need to do is buy a commercially available juniper berry oil, read the label and portion out the amount specified in the claims, or add the juniper berry oil to a brewed fermented malt beverage, and taste it. Thus, the claims are enabled and definite.

In view of the foregoing and the fact that the Examiner previously indicated all of the claims on Appeal to be allowable, and then reversed himself inexplicably rejected the same claims, points to the Examiners arbitrary and capricious rejection of the application.

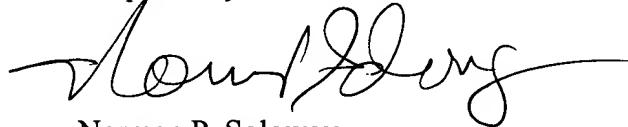
Accordingly, it is respectfully requested that the Examiner's rejection of the subject application be reversed in all respects.

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Respectfully submitted,



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APPENDIX A- CLAIMS ON APPEAL

APPENDIX A

CLAIMS ON APPEAL

Claim 1: A method of reducing bitterness of a brewed fermented malt beverage which comprises adding to said fermented beverage juniper berry oil in a below a threshold of taste amount of 0.010 ppm to 0.350 ppm based on said malt beverage.

Claim 2: A method according to claim 1, wherein said juniper berry oil is added during aging of the beverage.

Claim 3: A method according to claim 1, wherein said juniper berry oil is added following aging of and before packaging of the beverage.

Claim 4: A method according to claim 1, wherein said juniper berry oil is added as an extract.

Claim 5: A method according to claim 3, wherein said juniper berry oil is added as fresh or dried berries which are removed prior to packaging.

Claim 7: A method according to claim 1, wherein said juniper berry oil is added to said malt beverage in an amount of 0.015 ppm to 0.070 ppm based on said malt beverage.

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UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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10

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

This application is in condition for allowance except for the presence of claims 8-11 drawn to an invention non-elected with traverse in Paper No. 5. Applicant is given ONE MONTH or THIRTY DAYS from the date of this letter, whichever is longer, to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis E. Sherrer whose telephone number is 703-308-3847. The examiner can normally be reached on Tuesday-Friday, 8AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3602 for regular communications and 703-305-3602 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Curtis E. Sherrer
Primary Examiner
Art Unit: 1761

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. Of: OWADES
Serial No.: 09/833,924
Filed: April 12, 2001
For: PROCESS FOR PRODUCING A MALT BEVERAGE ...
Group: 1761
Examiner: CURTIS EDWARD SHERRER DOCKET: OW-20

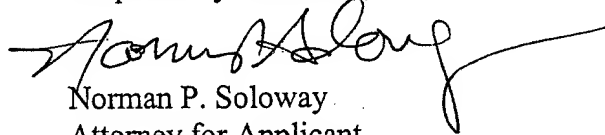
Commissioner for Patents
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INTERVIEW SUMMARY BY APPLICANT

Dear Sir:

A telephone interview was conducted between Applicant's attorney and Examiner Sherrer on October 8, 2003. In the Interview, Applicant's attorney queried Examiner Sherrer why he earlier indicated the Application to be allowable, and then reversed himself. Examiner Sherrer offered no explanation. No agreement was reached.

Respectfully submitted,



Norman P. Soloway
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 4, 2003, at Tucson, Arizona.

By



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